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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,466	07/29/2003	Anandan Palani	IN01481KB	7306
24265	7590	10/27/2005	EXAMINER	
SCHERING-PLOUGH CORPORATION PATENT DEPARTMENT (K-6-1, 1990) 2000 GALLOPING HILL ROAD KENILWORTH, NJ 07033-0530			CHANG, CELIA C	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,466

Applicant(s)

PALANI ET AL.

Examiner

Celia Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) 31-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of group I, the species of compound 8 on page 50 in the reply filed on Aug. 18, 2005 is acknowledged. The traversal is on the grounds that the examiner has not established a clear reason that i) separate classification, ii) separate status in the art or iii) different field of search, to justify restriction. This is not found persuasive because please note that the class and when possible, the subclasses of each group was clearly delineated in the office action. A very detailed explanation with respect to the required species election in the compound groups has also been delineated on page 4. Applicants were advised but provided no evidence that all the inventions are *obvious* variations being recognized by the state of the art. Please note that MPEP § 803.02 specifically defines that propriety of Markush grouping must evidence common utility and substantial structural feature disclosed as being essential to that utility. The substantial common structural feature must be and art recognized core. In re Harnish 205 USPQ 300. Applicants provided not evidence mere allegation that "the same art search will most probably apply to the alleged separate inventions". Please note that clear delineation of class and subclass in the previous office action *evidenced* such an allegation is erroneous.

The requirement is still deemed proper and is therefore made FINAL.

Based on the election, group I being drawn to claims 21-30 wherein R1 and R2 are non-heterocyclic, R3 is substituted or unsubstituted pyrimidine are examined. Claims 31-40 and the remaining subject matter of claims 21-30 are withdrawn from consideration. Should applicant insisted upon that all the inventions are not patentably distinct, then there could have been no patentability of all the claims over Jassens et al. CA 104:50874 wherein compounds of formula I when R2, R9, R10, B, A are hydrogen, R3 is substituted phenyl, R1 is MR4, R4 is R8-heteroaryl, C1 alkyl and R8 is halogen is clearly anticipated.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21, 25, 27, 29 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US2004/0142920, see page 11, example 58.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albert et al. US 2004/0142920.

Determination of the scope and content of the prior art (MPEP §2141.01)

Albert et al. '920 has an effective filing date of April 9, 2001 (see priority documents for WO 02/081449). An anticipatory compound against the generic scope being examined, compounds of formula I wherein R1 and R2 are non-heterocyclic, R3 is substituted or unsubstituted pyrimidine has been delineated supra.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the elected species and Albert et al.'920 reference is that instead of both R1 and R2 are optionally substituted phenyl, the instantly elected species has one of the R2 moiety being benzyl. Generically, Albert et al. '920 taught that R2 being phenyl or benzyl are optional choices for such moiety (see p.1, example 58 vs p.14, example 82).

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Finding of prima facie obviousness—rational and motivation (MPEP§2142-2143)

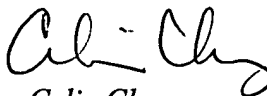
One having ordinary skill in the art would be motivated to modify the species of the elected compound with the generically taught optionally choices of equivalency in replacing the phenyl moiety with a benzyl moiety with the expectation that such modification would render the modified compound having similar biological activity.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Oct. 20, 2005


Celia Chang
Primary Examiner
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